

## REMARKS

### **I. Introduction**

Claims 1-8 are pending in the present application. Claims 1 and 8 have been amended. In view of the preceding amendments and following remarks, it is respectfully submitted that claims 1-8 are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1, 2, 6 and 8 under 35 U.S.C. § 102(b)**

Claims 1, 2, 6 and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,811,671 ("Seekircher"). Applicants respectfully submit that claims 1, 2, 6 and 8 are not anticipated by the applied reference, for at least the reasons set forth below.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, **arranged exactly as in the claim**. Lindeman, 730 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In the "Response to Arguments" section of the Office Action, the Examiner states that "the engine control unit and testing control unit [of Seekircher] are being interpreted as being one control unit because the claim does not specify that the control unit being one processor." In response, Applicants have amended claim 1 to recite, in relevant parts, "controlling a fuel metering by the single, integrated control unit during operation, wherein only the single, integrated control unit performs the checking, driving, evaluating, and

controlling steps, wherein no other control unit performs the steps of checking, driving, evaluating, and controlling.” Claim 8 has been similarly amended to recite, in relevant parts, “a **single, integrated control unit** for testing injector contacts during an initialization phase prior to starting up the fuel metering system, for controlling injectors for a test, for evaluating at least one of (a) current values and (b) voltage values for error detection purposes, and for controlling a fuel metering during operation.” Applicants note that there is no reasonable way to interpret the disclosure of Seekircher as disclosing the above-recited amended features of claims 1 and 8, since there is no suggestion in Seekircher that the testing control unit 9 is part of a “**single, integrated control unit**” that also includes the engine control unit. In fact, Seekircher does not even show the engine control unit (see, e.g., Fig. 1 and col. 4, l. 13-17). In any case, col. 4, l. 13-17 of Seekircher clearly describes that the engine control unit controls the internal combustion engine, and col. 4, l. 52-53 of Seekircher clearly describes that a separate testing control unit 9 triggers the users during testing and implements the analysis. Accordingly, there is no question that Seekircher teaches two separate control units, directly in contrast to the claimed feature that “**only the single, integrated control unit performs the checking, driving, evaluating, and controlling steps, wherein no other control unit performs the steps of checking, driving, evaluating, and controlling,**” as recited in claim 1, and as similarly recited in claim 8.

For at least the foregoing reasons, claim 1 and its dependent claims 2, 6 and 8 are not anticipated by Seekircher.

### III. **Rejection of Claim 3 under 35 U.S.C. §103(a)**

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,811,671 (“Seekircher”), in view of U.S. Patent No. 6,293,251 (“Hemmerlein”). Applicants submit that the combination of Seekircher and Hemmerlein fails to render obvious claim 3 for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 3 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, Hemmerlein clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Hemmerlein fail to render obvious claim 1 and its dependent claim 3.

For at least the reasons stated above, claim 3 is patentable over the combination of Seekircher and Hemmerlein. Withdrawal of the rejection of claim 3 is respectfully requested.

#### **IV. Rejection of Claim 4 under 35 U.S.C. § 103(a)**

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,811,671 ("Seekircher"), in view of U.S. Patent No. 5,633,458 ("Pauli"). Applicants submit that the combination of Seekircher and Pauli fails to render obvious claim 4 for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 4 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, Pauli clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Pauli fail to render obvious claim 1 and its dependent claim 4.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 7 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, De Leo clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Di Leo fail to render obvious claim 1 and its dependent claim 7.


For at least the reasons stated above, claim 7 is patentable over the combination of Seekircher and Di Leo. Withdrawal of the rejection of claim 7 is respectfully requested.

### CONCLUSION

It is therefore respectfully submitted that the pending claims 1-8 are allowable. All issues raised by the Examiner have been addressed, and an early and favorable action on the merits is solicited.

Respectfully submitted,

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